



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,716	10/06/2006	Juan Manuel Pedraza Sanz	130260.00201	3258
21369 7590 07/29/2009 PEPPER HAMILTON LLP ONE MELLON CENTER, 50TH FLOOR 500 GRANT STREET PITTSBURGH, PA 15219				
EXAMINER				
ANGWIN, DAVID PATRICK				
ART UNIT		PAPER NUMBER		
3729				
MAIL DATE		DELIVERY MODE		
07/29/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/599,716

Applicant(s)

PEDRAZA SANZ, JUAN MANUEL

Examiner

DAVID P. ANGIN

Art Unit

3729

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 4 and 7-12 is/are pending in the application.
- 4a) Of the above claim(s) 1, 3 and 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/22/09 has been entered.

Election/Restrictions

Applicant's election with traverse of Species II (claims 7-12) in the reply filed on 6/22/09 is acknowledged. The traversal is on the ground(s) that Species I and II are equivalent in scope. This is not found persuasive because the scope of the claim set is defined by the broadest claim. Species I (claim 1 is broadest) requires "a set of vertical wheels mounted on the vertical axle and a horizontal wheel mounted on the horizontal axle which work on the conductor to be coiled so that turns are formed without the need to involve manual work thereon" (claim 1, lines 5-7), whereas Species II does not require this limitation. Species II requires "a control unit" (claim 7, line 3), "a pressure head operatively connected to the control unit and mounted on a support around which the pressure head pivots" (claim 7, line 4-5), and "at least one vertical wheel mounted on the vertical axle and at least one horizontal wheel mounted on the horizontal axle

positioned to accept a conductor material and form the conductor material into a coil" (claim 7, lines 9-11), whereas Species I does not require these limitations.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1 and 3-4 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically:

- a. **Claim 9** recites the following limitations that are vague, indefinite, and confusing:
 - "the control unit determines the commands to transmit based upon a shape..." (claim 9, lines 1-2) - It is unclear as to what object must be in "a shape" for the control unit to determine the command to transmit. It is unclear if the claim means "a shape" of the coils, the conductor, or another object. Please be more precise with the claim language.

Claim Rejections – 35 USC § 103

The following is a quotation of 35 U.S.C. § 103(a) that forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically taught or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. § 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 7 and 10-11, as best understood, are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Okuda et al* (JP 11-345732) in view of *Hartwig* (DE 2530312) and *Stjepan et al* (US 6,910,360).

- a. *Okuda et al* discloses the following:
- i. a control unit (Figs. 1-13, item 121);
 - ii. a pressure head (Figs. 1, 3, and 4, items 126 and 127) operably connected to the control unit and mounted on a support (Figs. 1-13, items 30 and 122) around which the pressure head pivots, the pressure head having a vertical axle (Fig. 3, item 127; *axle holding wheel item 127*) and a horizontal axle (Fig. 3, *axle holding wheel item 126*);
 - iii. at least one vertical wheel (Fig. 3, item 127) mounted on the vertical axle and at least one horizontal wheel (Fig. 3, item 126) mounted on the horizontal axle positioned to accept a conductor

material (Fig. 3, item 25) and form the conductor material into a coil;

- iv. at least one cylinder (Fig. 4, item 124) attached to the vertical and horizontal axles, the cylinder operably connected to the control unit and configured to adjust coiling pressure exerted on the conductor material by adjusting hydraulic pressure on the axles; and
 - v. a conductor feeder (Figs. 3 and 7, items 20 and 61) mounted on the support, the feeder comprising a set of clamps (Figs. 3 and 7, item 64) such that the conductor to be coiled is positioned tangent to the vertical and horizontal wheels, thus eliminating traction tensions in the conductor as well as a risk of stretching the conductor during coiling.
- b. Regarding claim 7, in addition to the above limitations, *Okuda et al* may not expressly disclose utilizing a control unit.
- i. However, *Stjepan et al* teaches in his reference utilizing a control unit (Figs. 10-11; 5:33-57). The advantage of utilizing a control unit is to automate the coil manufacturing process. Therefore, it would have been obvious to utilize a control unit to automate the coil manufacturing process.
- c. Regarding claim 7, in addition to the above limitations, *Okuda et al* may not expressly disclose utilizing at least one hydraulic cylinder attached to the vertical and horizontal axles, the hydraulic cylinder operably connected to the control unit and configured to adjust coiling pressure exerted on the conductor material by adjusting hydraulic pressure on the axles.
- i. However, *Hartwig* teaches in his reference at least one hydraulic cylinder (2:45) used during coiling, the hydraulic cylinder operably connected to a control unit and configured to adjust coiling pressure exerted on the conductor material by adjusting hydraulic pressure (2:33-48; Figs. 1-2). The advantage of utilizing at least one

hydraulic cylinder used during coiling, the hydraulic cylinder operably connected to the control unit and configured to adjust coiling pressure exerted on the conductor material by adjusting hydraulic pressure is to more precisely control the winding process. Thus, it would have been obvious to utilize at least one hydraulic cylinder attached to the vertical and horizontal axles, the hydraulic cylinder operably connected to the control unit and configured to adjust coiling pressure exerted on the conductor material by adjusting hydraulic pressure on the axles to more precisely control the winding process.

- d. Regarding claims 10-11, in addition to the limitations in claim 7, *Okuda et al* may not expressly disclose utilizing a control unit that comprises a user interface having an input device.
- i. However, *Stjepan et al* teaches in his reference utilizing a control unit that comprises a user interface having an input device and an input/output interface (Figs. 10-11; 5:33-57). The advantage of utilizing a control unit that comprises a user interface having an input device and an input/output interface is to more precisely and effectively automate the process. Therefore, it would have been obvious to utilize a control unit that comprises a user interface having an input device and an input/output interface to more precisely and effectively automate the process.

Claims 8-9 and 12, as best understood, are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Okuda et al* (JP 11-345732) in view of *Hartwig* (DE 2530312) and *Stjepan et al* (US 6,910,360) and further in view of *Chang et al* (US Patent 5,644,486).

- a. Regarding claim 8, in addition to the limitations in claim 7, *Okuda et al* as modified may not expressly disclose that the control unit transmits commands to the hydraulic cylinder to maintain the coiling pressure on the

vertical and horizontal axles according to an acceptable pressure threshold.

- i. However, *Hartwig et al* teaches in his reference utilizing a control unit that controls a hydraulic cylinder to maintain the coiling pressure within an acceptable pressure threshold (Fig. 2; 2:31-48). The advantage of utilizing a control unit that controls a hydraulic cylinder to maintain the coiling pressure within an acceptable pressure threshold is to precisely control the movement of mechanical devices. Thus, it would have been obvious to utilize a control unit that controls a hydraulic cylinder to maintain the coiling pressure within an acceptable pressure threshold to precisely control the movement of mechanical devices.
 - ii. In addition, *Chang et al* teaches in his reference a control unit (1:10-23; Fig. 1) that transmits commands to mechanical devices. The advantage of using a control unit to transmit commands to mechanical devices is to precisely control the movement of the mechanical devices. Thus, it would have been obvious to use a control unit to transmit commands to the hydraulic cylinder to maintain the coiling pressure on the vertical and horizontal axles according to an acceptable pressure threshold.
- b. Regarding claim 9, in addition to the limitations in claim 8, *Okuda et al* as modified may not expressly disclose that the control unit determines the commands to transmit based upon a shape, a number of turns of a coil to be manufactured, and any programmed stops for manual work on the coil.
- i. However, *Stjepan et al* teaches in his reference utilizing a control unit to determine the commands to transmit based upon a shape, a number of turns of a coil to be manufactured, and any programmed stops for manual work on the coil (Figs. 10-11; 5:33-57). The advantage of utilizing a control unit to determine the commands to transmit based upon a shape, a number of turns of a coil to be manufactured, and any programmed stops for manual work on the coil is to precisely and effectively coil wire. Thus, it would have been obvious to utilize a control unit to determine the commands to transmit based upon a shape, a number of turns of a coil to be

manufactured, and any programmed stops for manual work on the coil is to precisely and effectively coil wire.

- c. Regarding claim 12, in addition to the limitations in claim 8, *Okuda et al* may not expressly disclose utilizing a control unit that outputs data via a communications network, the data including at least one of dimensions of finished coils, coiling time, programmed stop time, set up time, and any alarms.
- i. However, *Stjepan et al* teaches in his reference utilizing a control unit that outputs data via a communications network, the data including at least one of dimensions of finished coils, coiling time, programmed stop time, set up time, and any alarms (Figs. 10-11; 5:33-57). The advantage of utilizing a control unit that outputs data via a communications network, the data including at least one of dimensions of finished coils, coiling time, programmed stop time, set up time, and any alarms is to more precisely and effectively automate the process. Therefore, it would have been obvious to utilizing a control unit that outputs data via a communications network, the data including at least one of dimensions of finished coils, coiling time, programmed stop time, set up time, and any alarms to more precisely and effectively automate the process.

Response to Arguments

Applicant's arguments with respect to claims 7-12 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David P. Angwin whose telephone number is 571-270-3735. The examiner can normally be reached on 7:30 AM - 5 PM (M-F).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks, can be reached on 571-272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. Dexter Tugbang/
Primary Examiner
Art Unit 3729

DPA
July 28, 2009